

**REMARKS/ARGUMENTS**

Claims **1** and **38-62** were pending in this application. According to the June 22, 2007 Office Action, claims **1** and **38-62** were rejected.

We have amended independent claims **1** and **62** and dependent claims **38-42** and **45-60**, and have added new independent claim **68** and new dependent claims **63-67** to recite particular embodiments that we, in our business judgment, have currently determined to be commercially desirable. We have canceled independent claim **43** and dependent claims **44** and **61**. We will pursue the subject matter of the previously presented and canceled claims in one or more continuing applications. The amendments do not introduce any new matter.

Accordingly, the following claims are under consideration:

- Independent claims **1, 62**, and **68**.
- Dependent claims **38-42, 45-60**, and **63-67**.

**1.0 Rejection of the claims under 35 U.S.C. § 101**

The Examiner rejected previously presented independent claims **1, 43**, and **62** under 35 U.S.C. § 101, indicating that the “claimed invention lacks patentable utility” and that the claims “lack[] a concrete result.”

35 U.S.C. § 101 requires that an invention for which patent protection is sought be (i) “useful” and (ii) that it fall within one of the four enumerated statutory categories. The Examiner’s rejection is ambiguous because the Examiner appeared to link these two requirements. In other words, the Examiner appeared to assert that the claimed invention lacks patentable utility (i.e., is not useful) *because* the claimed invention lacks a concrete result (i.e., the claimed invention is not directed to statutory subject matter). We will proceed under the assumption that the Examiner intended to make two separate rejections or in other words, intended to reject the claimed invention (i) as not being useful and (ii) as not being directed to statutory subject matter. In both cases, the Examiner failed to make a *prima facie* case.

Regarding a rejection that the claimed invention is not useful, MPEP § 2107 states that “[a]ny rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility.” The Examiner did not articulate why the claimed invention has no specific and substantial credible utility and as such, failed to establish a *prima facie* case under 35 U.S.C. § 101 with respect to the claimed invention not being useful.

Regarding a rejection that the claimed invention is not directed to statutory subject matter, the Federal Circuit has held that a claimed invention need only produce a useful, concrete, and tangible result to constitute statutory subject matter under 35 U.S.C. § 101. AT & T Corp. v. Excel Communications Inc., 172 F.3d 1352, 1356 (Fed. Cir. 1999); State Street Bank v. Signature Financial Trust, 149 F.3d 1368, 1373 (Fed. Cir. 1998). In rejecting the claims, the Examiner asserted that the claims “lack[] a concrete result” because the process is not “repeatable.” First, in asserting that the claimed invention lacks a concrete result the Examiner appeared to indicate that “useful, concrete, and tangible” are three separate requirements that must be met. However, the courts have defined the phrase “useful, concrete, and tangible” as one unified test, not as three separate requirements that must be met. AT & T Corp., 172 F.3d at 1358-60. Accordingly, the breaking apart of useful, concrete, and tangible as three separate requirements, as the Examiner appeared to assert, is unsupported by law and is thus improper. Second, even assuming, *arguendo*, that useful, concrete, and tangible are three separate requirements, the courts have never held that for a claimed invention to have a concrete result the claimed invention must be “repeatable.” Accordingly, the Examiner’s rejection is improper and as such, the Examiner failed to establish a *prima facie* case under 35 U.S.C. § 101 with respect to the claimed invention not being directed to statutory subject matter.

## **2.0 Rejection of the claims under 35 U.S.C. § 112**

The Examiner rejected previously presented claims 1 and 38-62 under 35 U.S.C. § 112, second paragraph, as being indefinite because “‘insufficient credit ranking’ and ‘sufficient credit ranking’ are subject and not quantifiable in terms of minimum credit ranking and credit ranking.”

The Examiner failed to establish a *prima facie* case of indefiniteness for any of these claims. Specifically, under 35 U.S.C. § 112, second paragraph,

[t]he requirement to ‘distinctly’ claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles...**Only when a claim remains insolubly ambiguous without a discernible meaning** after all reasonable attempts at construction must a court declare it indefinite.

(emphasis added); Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354, 1366 (Fed. Cir. 2004); MPEP § 2173.02.

The Examiner failed to show that any of previously presented claims **1** and **38-62** are “insolubly ambiguous without a discernible meaning.” In fact, the record shows the opposite to be true in that the Examiner was able to articulate a rejection of the claims in view of the cited references. Accordingly, previously presented claims **1** and **38-62** are not “insolubly ambiguous without a discernible meaning” and the Examiner thereby failed to establish a *prima facie* case of indefiniteness with respect to these claims.

In addition, currently presented claims **1**, **38-42**, **45-60**, and **62-68** recite an apparatus comprising at least one computing device operable to perform the recited limitations. We respectfully submit that in the context of a computing device, an insufficient credit ranking is both objective and quantifiable in terms of a minimum credit ranking.

### **3.0 Rejection of the claims under 35 U.S.C. § 103(a)**

The Examiner rejected previously presented claims **1** and **38-61** under 35 U.S.C. § 103(a) as being unpatentable over Silverman, patent 5,924,082 (hereinafter Silverman) in view of Wilton et al., patent 7,080,033 (hereinafter Wilton), and in further view of Tozzoli et al., patent 5,717,989 (hereinafter Tozzoli) and rejected previously presented claim **62** under 35 U.S.C. § 103(a) as being unpatentable over Silverman in view of Tozzoli.

As indicated, independent claims **1** and **62** and dependent claims **38-42** and **45-60** have been amended, independent claim **43** and dependent claims **44** and **61** have been canceled, and new independent claim **68** and new dependent claims **63-67** have been added.

Independent claim **1** (and similarly independent claims **62** and **68** and the claims that depend from independent claims **1**, **62** and **68**) recites in part an apparatus comprising at least one computing device operable to:

*prevent the party from placing orders in the market based at least in part on determining that the party's credit ranking is insufficient for the party to trade with at least one of the participants in the market.*

We respectfully submit that neither Silverman, Wilton, nor Tozzoli has been shown to teach or suggest such limitations and as such, these references, alone or in combination, have not been shown to obviate the claims.

In particular, Silverman appears to disclose a system that uses credit rankings to control the displaying and matching of entered orders (e.g., see Silverman, column 7, line 12 to column 8, line 58; column 9, lines 25-29). However, Silverman has not been shown to disclose the use of credit rankings to “*prevent the party from placing orders in the market*” or

more specifically, has not been shown to disclose “*prevent[ing] the party from placing orders in the market based at least in part on determining that the party's credit ranking is insufficient for the party to trade with at least one of the participants in the market.*”

Wilton appears to disclose a system in which there must be sufficient bilateral credit available between trading entities to enable execution of a transaction directly between the entities (e.g., see Wilton, column 7, lines 6-39; column 11, line 15 to column 12, line 3). However, Wilton has not been shown to disclose the use of bilateral credit availability to “*prevent the party from placing orders in the market*” or more specifically, has not been shown to disclose “*prevent[ing] the party from placing orders in the market based at least in part on determining that the party's credit ranking is insufficient for the party to trade with at least one of the participants in the market.*”

Tozzoli appears to disclose a system in which a buyer's and a seller's access to the system is controlled by a funder and a trade system administrator (e.g., see Tozzoli, column 5, line 46 to column 6, line 44). However, Tozzoli has not been shown to disclose “*prevent[ing] the party from placing orders in the market based at least in part on determining that the party's credit ranking is insufficient for the party to trade with at least one of the participants in the market.*”

Accordingly, because Silverman, Wilton, and Tozzoli have not been shown to teach or suggest at least the above noted limitations of the claims, these references, alone or in combination, have not been shown to obviate the claims.

#### **4.0 Conclusion**

In view of the amendments and remarks, we respectfully submit that the claims are in condition for allowance. We request that the application be passed to issue in due course. The Examiner is urged to telephone our undersigned representative at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.

Respectfully submitted,

/Glen R. Farbanish/

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Date

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Glen R. Farbanish  
Reg. No. 50,561  
Attorney for Applicants  
(212) 294-7733